

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 6-6-03

APPL. S.N.: 091 696,709

TO EXAMINER: S. Snedden

ART UNIT: 1653

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 5-29-03

AFTER FINAL YES ☐ NO ☒ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP.**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



PATENT

Attorney Docket No.: 11016US05/100-236.P2.C2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:

Lewis H. Lambert

Serial No.: 09/696,709

Filed: October 24, 2000

For: IMPROVED THERAPEUTIC
COMPOSITIONS COMPRISING
BACTERICIDAL/PERMEABILITY-
INCREASING (BPI) PROTEIN
PRODUCTS

Examiner: Sheridan K. Snedden

Group Art Unit: 1653

Conf. No.: 3310

Express Mail No. EV 327683289 US

Date of Mailing: May 29, 2003

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TERMINAL DISCLAIMER UNDER 37 C.F.R. §1.321(c)

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

XOMA Technology Ltd. is the owner of the entire right, title and interest in the above-identified patent application as shown by the assignment recorded on February 23, 1996 at Reel 7835, Frame 0703 in application U.S. Serial No. 08/586,133 and is the assignee of United States Patent No. 5,912,228 by virtue of an assignment recorded on February 23, 1996 at Reel 7835, Frame 0703. XOMA Technology Ltd. is a wholly-owned subsidiary of XOMA Ltd., c/o XOMA (US) LLC, 2910 Seventh Street, Berkeley, California 94710, both of which are limited liability companies of Bermuda (a dependent territory of the United Kingdom) and wherein XOMA Ltd. has resulted from merger and change of domicile of XOMA Corporation.

Owner hereby disclaims the terminal portion of the term of any patent granted on the above-identified application extending beyond the expiration date of the United States Patent No. 5,912,228, and hereby agrees that any patent so granted

on the above-identified application shall be enforceable only for and during such period that the legal title to said patent and the legal title to United States Patent No. 5,912,228 is commonly owned, this agreement to run with any patent granted on the above-entitled application and to be binding upon owner and its successors or assigns.

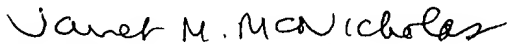
Owner does not disclaim any terminal portion of the term of any patent granted on the above-identified application prior to the expiration date of the full statutory term of United States Patent No. 5,912,228, in the event that said United States Patent No. 5,912,228 later expires for failure to pay a maintenance fee, are held unenforceable, are found invalid, are statutorily disclaimed in whole or in part or are terminally disclaimed under 37 CFR 1.321(a), have all claims canceled by a reexamination certificate, or are otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

The documents establishing the owner's chain of title have been reviewed by the undersigned and the undersigned certifies that to the best of his/her knowledge and belief, title is in the owner.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

DATED: May 29, 2003



Janet M. McNicholas, Ph.D.

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